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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,721	03/29/2001	Keiichi Onodera	P107156-00060	4071

7590

03/16/2006

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EXAMINER
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DAVIS, DAVID DONALD

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/819,721	<b>Applicant(s)</b> ONODERA ET AL.	
	<b>Examiner</b> David D. Davis	<b>Art Unit</b> 2652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-10,12,13 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10,12,13 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see the first paragraph of page 9, filed January 25, 2006, with respect to the rejection(s) of claim(s) 8, 12 and 22 under Ohira et al (US 5,748,607) in view of Tsutomu (JP 59-215892) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ohira et al (US 5,748,607) in view of Miyazaki et al (US 4,931,337).

### ***Claim Rejections - 35 USC § 112***

2. Claims 8-10, 12, 13, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically in lines 3 and 4 of claim 8, "the medium" is indefinite because it lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 9, 13, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohira et al (US 5,748,607). As per claim 8, Ohira et al shows in figure 2 a recordable disc 42 a first area 8 in which information can be recorded optically on one side of the disc 42. The first

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area 8 is configured such that the information can be written onto the disc 42 by irradiating the first area 8, and a second area 9 in which visual information can be recorded on another side.

Ohira et al also discloses in column 3, lines 25-47 and depicts in figure 5 the second area 9 configured such that an image pattern can be written onto the disc 42 by irradiating the second area 9. Ohira additionally shows in figure 2 that the first area 8 and the second area 9 sides are visually distinguishable from each other.

As per claim 9, Ohira et al shows in figure 2 that the first area 8 includes a first recording layer, and the second area 9 includes a second recording layer with both recording layers being made of different materials. As per claim 13, Ohira et al shows in figure 2 the visual information being a visual image pattern comprising text or a design. As per claim 20, Ohira et al shows in figure 5 that the visual information can be recorded on the second area 9 by a computer or audio device based on intent of a user. As per claim 21, Ohira et al discloses that information can be written in said first area 8 only one time and in said second area 9 only one time.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 10, 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohira et al (US 5,748,607) in view of Miyazaki et al (US 4,931,337). Ohira et al discloses the claimed invention. See the description, *supra*. However, Ohira et al is silent as to the first and second recording layers are made of different organic dye material; both the first and second areas being re-writable and a material in which a chemical change is caused by a given heat, such as a cyanine based organic dye and/or an azo based organic dye.

Miyazaki et al discloses in column 33, lines 15-30 and shows in figure 1 the recording layers 2a and 2b being formed from an organic dye that is not cyanine and a cyanine based organic dye.

It would have been obvious to a person having an ordinary skill in the art at the time the invention was made to provide the recording layers of Ohira et al with an organic dye that is not cyanine and a cyanine based organic dye as taught by Miyazaki et al. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to provide a recording layers with an organic dye that is not cyanine and a cyanine based organic dye "to provide an information recording medium that can solve, without any lowering of

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recording sensitivity, the problem in the conventional organic type optical recording medium having the hollow space structure.” See column 2, lines 5-14 of Miyazaki et al.

***Response to Arguments***

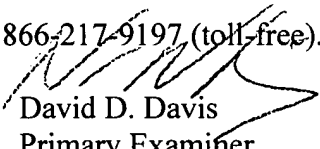
7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is 571-272-7572. The examiner can normally be reached on Monday thru Friday between 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
David D. Davis  
Primary Examiner  
Art Unit 2652

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